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**Remarks/Arguments**

Applicant respectfully traverses the rejections and requests reconsideration.

**I. Objections to the Specification**

The Examiner objected to the specification at page 20, lines 3-8, on the grounds that it is confusing. Applicants have amended the specification to add a clarifying example.

The examiner objected to the specification, at page 21, lines 3-5, as unclear. Applicants have amended the specification to clarify the function of subroutine 122 and to add an example.

**II. Claim Objections**

Claim 62 was rejected as incomplete. Applicants have amended claim 62 to depend from claim 49, as the Examiner suggested.

**III. Claim Rejections - 35 U.S.C. Section 101**

The Examiner rejected claims 49-63 under 35 U.S.C. section 101 as based on non-statutory subject matter. Applicants respectfully disagree.

As set forth in MPEP section 2106 and the "Guidelines Flowchart" included therein, the Examiner should determine whether the claimed invention satisfies section 101 as follows.

First, the Examiner should determine whether the claims fall within an enumerated statutory category (machine, manufacture, process, or composition). Here, the claims are directed to enumerated statutory subject matter. Independent claim 49 and dependent claims 50-62 are directed to a method (process) which is statutory subject matter. Claim 63 is directed to an apparatus, which is also statutory subject matter.

Second, the Examiner should determine whether the claims fall within a judicial exception to section 101 (abstract ideas, laws of nature, or natural phenomena). Here, the Examiner rejected the claims as a "method of only manipulating abstract idea and/or pure data." (Office Action, page 3, paragraph 5.) The invention is a method for editing a text

document and an apparatus that performs the method. Examples of abstract ideas are mathematical algorithms or compilations of data (numbers). The claimed invention is a series of steps -- a process -- not a compilation of data. The claimed method does not include an abstract idea nor act upon an abstract idea nor result in an abstract idea. The method functions to input a text document and to perform specific error-correcting functions on the written text of the document. Those functions are specific functions based on what makes a written work clearer, more concise, and more comfortable for a reader to read, and they act upon each word, phrase, or sentence of the text document that is inputted. The method performs the functions and produces a result: a corrected and edited document with the corrections and edits shown visually to the user. The method cannot function in the abstract -- it must have a specific document on which to operate. Thus, the method (and therefore also the apparatus) is not one that manipulates an abstract idea or pure data.

Even if the claimed method appears to be an abstract idea, however, the next step is for the Examiner to determine whether the invention is a practical application of an abstract idea rather than the abstract idea itself. As stated in MPEP section 2106, subsection IV(C): "While abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be. In evaluating whether a claim meets the requirements of section 101, the claim must be considered as a whole to determine whether it is for a particular application of an abstract idea, natural phenomenon, or a law of nature, and not for the abstract idea, natural phenomenon, or law of nature itself."

In this case, to the extent that the claimed method involves an abstract idea (which Applicants contend is not the case), it is patentable subject matter because it is not itself an abstract idea, but is a practical application. In determining whether the claimed invention is for the practical application of an abstract idea, the Examiner should consider whether it "produces a useful, concrete and tangible result." (MPEP section 2106, subsection IV(C)(2)(2).) The focus is on whether the final result is useful, tangible, and

concrete. (Id.) “Useful” means specific, substantial, and credible, as is required for an invention to meet the utility requirement of section 101. (Id. at subsection IV(C)(2)(2)(a).) “Tangible” means to produce a real-world result. (Id. at subsection IV(C)(2)(2)(b).) “Concrete” means that the result is repeatable and reproducible, not unpredictable. (Id. at subsection IV(C)(2)(2)(c).)

Here, the claimed invention produces a result that is an edited document displaying the corrections that have been made and, in most cases, offering the user a choice of whether to accept or decline the correction. This is clearly a result that is useful, tangible, and concrete. The result is useful and utilitarian because it is specific, substantial, and credible as it acts on a particular document, and on particular words, phrases, or sentences within the document, and applies specific rules and principles. It produces a highly practical result: a revised document which is clear, concise, and comfortable to read. The result is tangible because it is a “real-world” result: writers are provided with specific suggestions to improve the clarity and quality of their writing. The result is concrete because it is repeatable and predictable -- the method performs the same actions (functions) to the same words each time.

Accordingly, the claimed invention (method and apparatus) is statutory subject matter. The rejection under section 101 should be withdrawn.

#### **IV. Claim Rejections - 35 U.S.C. Section 112, Second Paragraph**

##### **A. Claims 49-63**

The Examiner rejected claims 49-63 as indefinite based on the use of the terms “clarity,” “conciseness,” and “reader discomfort.” Applicants respectfully disagree.

Applicants do not believe that these terms are highly subjective or uncertain to a person skilled in the art, having read the specification. The words “clarity” and “conciseness” do not need to be defined as they are used in their common meanings: “clarity” means “the quality or state of being clear” and “concise” means “marked by brevity of expression or statement; free from elaboration and superfluous detail.” (See Webster’s Ninth New Collegiate Dictionary.)

"Reader comfort" is understood in the context of the specification, at pages 1-3.

At page 1, line 12 - page 2, line 4, the specification states:

"Business writers need to remember that even though a written piece may be grammatically and otherwise correct, it may remain unclear, boring or uncomfortable to read. The message must not get lost in the words. Constructions that confuse and frustrate readers most include: disconnected subject and verbs; weak verbs; misused prepositional phrases; repetitive sentence styles; and, too few transitional words and unifying topical links within paragraphs."

At page 2, lines 11-12, the specification states: "Ultimately, what business writers should strive for is best described as 'reader comfort.'" The specification describes points indicating reader discomfort (page 2, lines 29-31), and provides a list of items that cause reader discomfort in figure 3B. Thus, the phrase "reader comfort" is defined in the context of "reader discomfort," which is defined as writing which is confusing and frustrating to the reader.

#### **B. Claims 50-52**

Claims 50-52 were rejected as indefinite in that there is no antecedent basis for the following limitations: "the word 'responsible,'" "the verb form," "the word 'It,'" and "the word 'There'."

Applicants believe that a person reasonably skilled in the art having read the specification would understand that these phrases all refer to each instance in the text document where these words occur. Applicants believe it is clear that if the word "responsible" is not in the document, then the error-correcting function of claim 50 will not be used, but if the word "responsible" is in the document, then each time it is used, the error-correcting function will replace it with the verb form of the gerund that follows.

Applicants have amended claims 50-52 to be clearer, to emphasize that the error-correcting functions are performed in each instance where the word or phrase in question is used.

The Examiner has also rejected claims 50-52 on the grounds that the words "responsible," "it," and "there" are non-statutory subject matter as non-functional

descriptive material. Applicants believe that this rejection is improper for the reasons set forth in section III above and as follows.

To determine if a claim contains statutory subject matter, it is to be analyzed under the flowchart described above. These claims as a whole are practical applications that produce useful, tangible, and concrete results. The words in question are not non-functional descriptive material. Non-functional descriptive material includes "music, literary works, and a compilation or mere arrangement of data." (MPEP § 2106.01). It is non-statutory "when claimed as descriptive material *per se*." *Id.* That is not the case here. The claims do not claim the words "responsible," "it," or "there;" they claim a method of editing a text document which requires error-correcting functions, where specific error-correcting functions replace these words with other words or groups of words.

#### **C. Claims 53-55**

Claims 53-55 have been rejected on the grounds that the phrase "three or more prepositions in a row" is relative/uncertain and indefinite.

Applicants have amended claims 53-55 to state: "three or more consecutive prepositional phrases" for clarity. The length of the row, font of the letters, and position of the sentence are irrelevant. In the context of the specification (see page 8, line 21 - page 10, line 14), there is no uncertainty in the phrase "three consecutive prepositional phrases." The limitation is not indefinite.

The Examiner has also rejected claim 53 on the grounds that "attempting to collapse" is indefinite. Applicants have changed "attempting to collapse" to "reducing" to clarify the claim.

#### **V. Claim Rejections - 35 U.S.C. Section 112, First Paragraph.**

The Examiner has rejected claims 53-63 as failing to satisfy the enablement requirement on the grounds that the claimed error-correcting functions may not work in some sentences.

Applicants disagree. The method of the invention applies the error-correcting functions and then visually displays the corrected phrase or sentence or several

alternative corrections. In some cases, the error-correcting functions are automatic, but many are interactive and require the input of the user. (See specification, page 19, lines 10-12, 15-18, and 27-29; page 20, lines 18-20; page 21, lines 6 and 17; and page 22, lines 1-4.) The user will need to accept, decline, or modify the proposed correction. A person skilled in the art, having read the specification, would not need to perform undue experimentation to use the invention. Such persons would know that in some instances, the error-correcting principles will not work, just as users of spell-checker programs know that sometimes they should decline the proposed correction based on common knowledge of custom and usage. Users of the claimed invention are business writers who would have this skill and would understand that the claimed method offers proposed corrections that they must decide to accept or decline. The fact that the user has a choice of whether to apply the proposed correction does not make the claimed invention unenabled.

Applicants have amended Claim 63 to add the structure disclosed in the specification. (See specification, page 4, lines 9-17 and Fig. 1.)

**VI. Claim Rejections - 35 U.S.C. Section 102(e)**

The Examiner has rejected claims 49 and 63 under section 102(e) based on Lewis (U.S. 2002/0002459 A1). Lewis does not anticipate claims 49 and 63 as it does not disclose all of the elements of the claims.

Claim 49 requires inputting a text document. The text document is input from data storage device 22, communications link 20, or keyboard 18, or it may be scanned. The claimed method does not operate without having a text document upon which it can perform the error-correcting functions. Lewis does not disclose inputting a text document. Lewis receives audio signals (dictation) and creates a text document from the audio signals. (See Lewis, ¶0039.) The reference in paragraph 0007 of Lewis to "text input" refers in general to the existing processes of speech dictation or voice recognition software which require text input (meaning, dictation of the text), proofreading, and correction.

In addition, Lewis does not disclose conducting error-correcting functions to achieve reader comfort, as that term is used in Applicants' specification. (See specification, pages 1-3 and figure 3B, which lists specific aspects of writing that cause reader discomfort.) Lewis discloses only "proofreading criteria" associated with dictation (see Lewis, ¶0012); for example, homophones, preset grade or confidence level, homonyms, confusable word switching, and grammar rules (see Lewis, ¶0041).

#### **VII. Claim Rejections - 35 U.S.C. Section 103**

The Examiner rejects claims 50-52 as obvious over Lewis; claims 53-56 as obvious over Lewis in view of Saraki; claim 57 as obvious over Lewis, Saraki, and well-known prior art; and claims 58-62 as obvious over Lewis and well-known prior art.

Claims 50-62 are not obvious as the specific error-correcting functions are not disclosed in any of these references. In addition, there is no motivation or teaching in Lewis or Saraki to combine these references. Lewis's invention is voice-recognition dictation software, while Saraki's invention is translation software. Saraki begins with a text document in one language and translates it into a text document in a second language. There is no teaching or suggestion to combine Saraki with Lewis.

Moreover, it is impermissible for the Examiner to use hindsight, in light of Applicants' specification, to pick and choose relevant limitations from other references or to state that they are "well-known in the prior art." There is no stated basis for these conclusions.

However, Applicants have submitted new claim 64 which combines the error-correcting functions of existing claims 50-53, 56, 59, and 61. This combination of functions does not appear in any of the cited references, nor is it well known that reader comfort is enhanced by applying this particular set of principles to a written work. Accordingly, claim 64 is not obvious based on these references or on well known prior art.

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**VIII. Conclusion**

Applicants have amended claims 50-55, 62, and 63 and added new claim 64 to overcome the rejections. Applicants believe that these claims are allowable. Applicants respectfully request that the Examiner pass this case to issue.

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Respectfully submitted,

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